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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,294	09/26/2003	Shubhasheesh Anand	50269-0600	9385
29989 7590 12/01/2009 HICKMAN PALERMO TRUONG & BECKER, LLP 2055 GATEWAY PLACE SUITE 550 SAN JOSE, CA 95110				
EXAMINER CHAMPAGNE, DONALD				
ART UNIT 3688		PAPER NUMBER		
MAIL DATE 12/01/2009		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/672,294

Applicant(s)

ANAND ET AL.

Examiner

Donald L. Champagne

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date 7/22/2009
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 15 September 2009 has been entered.

Withdrawal of Claim Rejections - 35 USC § 112

2. The following rejections were made in the last Office action (mailed 15 June 2009):

"2. Claims 17-38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

At each independent claim 17 (line 3) and 26 (line 5), 'a search initiated by a user' is new matter. See the discussion in para. 5 below.

4. Claims 17-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. At each independent claim 17 (line 4) and 26 (line 5), 'a search initiated by a user' is indefinite.
5. The application does not disclose 'a search initiated by a user'. The application does disclose a user 'performs/performing' a search (para. [0020] and [0021] of the published application, US 20050076130A1). A user 'performing' a search necessarily entails a user *initiating* a search, but does not provide support for *initiating* because one of ordinary skill in the art would understand 'initiating' to be broader than 'perform'. See the Google definitions. 'performing' has the common meaning of doing some certain thing to completion, such as performing a wedding, doing the painting or performing a triple pirouette. By contrast, 'initiate' has the common meaning of starting something without

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necessarily finishing it, such as initiating a new program or starting a foundation. Hence, in the present context, any action taken by a user which eventually leads to a search reads on initiating a search, and that search, even if one or more steps removed from the user action, reads on 'a search initiated by a user'.

3. These rejections are hereby withdrawn because the logic is backwards. "Perform" is broader than "initiating", not vice versa. As the explanation (para. 5 above) makes clear, *initiating* a search is a necessary first step in *performing* said search. Since "performing" is supported by the spec., "initiating" is also necessarily supported. The examiner regrets any confusion, labor or cost that this error might have caused the applicants or their learned attorney.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 17-40 are rejected under 35 U.S.C. 101 because the claimed invention is not directed to statutory subject matter. Based on Supreme Court precedent, to be patent eligible under 35 U.S.C. 101 a method/process claim must (1) be tied to a particular machine or apparatus or (2) transform a particular article into a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 70 (1972); *Diamond v. Diehr*, 450 U.S. 192 (1981); *Parker v. Flook*, 437 U.S. 589 n.9 (1978); and *Cochrane v. Deener*, 94 U.S. 780, 788 (1876)). Furthermore, the Supreme Court held that the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patentability (*Benson*, 409 U.S. 71-72). The involvement of the machine or transformation must not merely be insignificant extra-solution activity (*Flook*, 437 U.S. 590). Also see *In re Bilski*, No. 2007-1130, _F.3d_, 2008 WL4757.
6. The instant claims fail to meet this test. The claims fail to transform a particular article into a different state or thing. The claims are tied to a machine or apparatus, a "client" (e.g., claim 17 line 2), but this is at best a nominal recitation that does not qualify as a *specific* machine and does not impose a meaningful limitation. Said client is tied only loosely to "storing", and

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all input/output, including storing and displaying, is regarded to be insignificant extra-solution activity.

7. This rejection can be overcome by tying at least one of either the steps, "performing a sponsored search" or "selecting a set of sponsored content" to a machine or apparatus. The examiner could not find any support in the spec. for tying "selecting a set of sponsored content" to a machine or apparatus. However, para. [0020] and [0022] of the published application (US 20050076130A1) disclose a "web search", which would be understood by one of ordinary skill in the art to mean a search on the World Wide Web, which is inherently tied to a machine or apparatus. Hence, this rejection can be overcome at least by amending claim 17 (line 6) and claim 26 (line 7) to "performing a sponsored web search".

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 17-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. At numerous places beginning with claim 17, lines 6-9), the following terms are indefinite, in part because none are clearly defined in the specification¹:

"sponsored search" and "sponsored content" – Para. [0020] in the published application discloses, "sponsored content" is content which "may be placed, ranked, or prioritized above other material in return for a premium payment, rate, or sponsorship fee." "may be" prevents this from being a clear definition. It would be a clear definition, and could be the basis for overcoming this rejection of "sponsored content", if the claims were limited to, "sponsored

¹ Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...". An example does not constitute a "clear definition" beyond the scope of the example.

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content is content which is placed, ranked, or prioritized above other material in return for a premium payment or sponsorship fee".²

"a second search term associated with the first search term used in the first search" -

The spec. does not disclose any basis for interpreting "associated", so virtually any two terms would read on this limitation.

"a non-search application" – This genus is defined in the spec. only by example (para. [0025]).¹ This rejection could be overcome by replacing the term "non-search application" with a clearly defined species, e.g., an email application (para. [0027] in the published application).

Claim Rejections - 35 USC § 102 and 35 USC § 103

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 17-22, 24, 26-31, 33, 39 and 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Smith et al. (US007089194B1, hereafter "Smith").

13. Smith teaches (independent claims 17 and 26) a machine-implemented method and machine-readable medium, the method comprising:

Storing (in *associated databases*, para. [0063]), remote to a client, a first search term (a *space odyssey* in the *SEARCH QUERY LIST* of Fig. 9) received from a user and used in a first search user;

² The meaning of "rate" in the spec. after "premium payment" is unclear.

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performing a sponsored search to retrieve sponsored content (para. [0187] and [0190], based on a second search term (either *a space odyssey* or *issac asimov* in the *SEARCH QUERY LIST* of Fig. 9) associated with the first search term used in the first search (the association is at least that the two terms were submitted in the same browsing session, para. [0187]);

selecting a set of sponsored content (Fig. 11 and para. [0193]) to integrate into information generated for display to said user by a non-search application (e.g., the non-product content of an email message such as its address);

integrating said set of sponsored content within said information and displaying the information with said set of sponsored content by the non-search application (para. [0097]).

14. Smith also teaches at the citations given above claims 18, 19, 21, 22, 27, 28, 30, 31, 39 and 40.
15. Claims 20, 24, 29 and 33 add only non-functional descriptive and were not given patentable weight (MPEP § 2106.01). Claim language not functional when it does not alter how the process steps are to be performed to achieve the utility of the invention.
16. Claims 23, 25, 32 and 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (US007089194B1, hereafter "Smith") in view of official notice.
17. Smith does not teach (claims 23, 25, 32 and 34) displaying sponsored content on a website other than a search engine website and in a banner advertisement. Opening the subject email through web-based email (i.e., email viewed at a website) would read on claims 23 and 32. Official notice is taken that web-based email was common at the time of the instant invention. A "banner ad" is interpreted as any ad which is wider than high. The combined ads 402 and 406, and the ad 404 taught by Smith (Fig. 11) read on banner ads. Since these banner ads are used for web page delivery it would be obvious to use them for email delivery.
18. Smith does not teach (claims 35-38) displaying sponsored content in an instant message. Official notice is taken that instant messaging was common at the time of the instant invention. To demonstrate this the examiner found 231 US patent documents for (1) applications filed prior to the instant application containing (2) common synonyms for and

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variants of "advertising" in the same sentence with "instant message/ing" and variants. The search has been made of record (EAST search "AMZN_and_email" performed 29 November 2009).

Response to Arguments

19. Applicant's arguments filed with an amendment on 15 September 2009 have been fully considered and addressed in the revised rejection given above.

Conclusion

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached on Monday to Wednesday and Friday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
21. The examiner's supervisor, Robert Weinhardt, can be reached on 571-272-6633. The fax phone number for all *formal* fax communications is 571-273-8300.
22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

29 November 2009

/Donald L. Champagne/
Primary Examiner, Art Unit 3688